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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/772,995	02/05/2004	Georg Heinrich Matzen	033794/273258	5386

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EXAMINER
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DUNWOODY, AARON M

ART UNIT	PAPER NUMBER
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3679

DATE MAILED: 04/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/772,995	MATZEN, GEORG HEINRICH	
	<b>Examiner</b>	<b>Art Unit</b>	
	Aaron M Dunwoody	3679	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 05 February 2004.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 18-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 15-17 and 25-27 is/are rejected.
- 7) ☒ Claim(s) 7-14 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 February 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/5/2004</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-17 and 25-27, drawn to an elastomeric expansion joint, classified in class 285, subclass 223.
- II. Claims 18-24, drawn to a method of manufacturing an elastomeric expansion joint, classified in class 29, subclass 890.014.

The inventions are distinct, each from the other because of the following reasons:

Inventions Group II and Group I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process which does not support the first reinforcement wiring on the first wiring support member, including winding the first reinforcement wiring in the retention regions.

Because these inventions are distinct for the reasons given above and the search required for Group II is not required for Group I, restriction for examination purposes as indicated is proper.

During a telephone conversation with Jason Cooper, Reg. No. 38114, on 3/25/2005 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-17 and 25-27. Affirmation of this election must be made by

Art Unit: 3679

applicant in replying to this Office action. Claims 18-24 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Priority***

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

***Information Disclosure Statement***

The information disclosure statement (IDS) filed 2/5/2004 is being considered by the examiner.

***Drawings***

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 7c. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Art Unit: 3679

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the at least one wiring support member must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Art Unit: 3679

The following title is suggested: Elastomeric Expansion Joint With A Wiring Support.

Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

The abstract of the disclosure is objected to because it fails to provide a concise statement of the technical disclosure for the instant application. Correction is required.

See MPEP § 608.01(b).

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: at least one wiring support member.

***Claim Rejections - 35 USC § 102***

Art Unit: 3679

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 15, 16 and 25-27 are rejected under 35 U.S.C. 102(b) as being anticipated by US patent 2879804, Hammond.

In regards to claim 1, Hammond discloses an elastomeric expansion joint comprising:

at least one first substrate (26);

at least one second substrate (24);

fabric layers (22) arranged between the first and the second substrates, defining a tubular section, wherein:

the tubular section comprises:

first and second end portions, a moveable central region (20), and

first and second intersection portions which are respectively defined

between each of the end portions and the central region, and the

intersection portions and the end portions define a reinforcement section;

a first reinforcement wiring (30, 31) positioned in the reinforcement section;

a second reinforcement wiring (34) positioned between the first and second substrates in the intersection portions; and

at least one wiring support member (36) positioned between the first and the second substrates, wherein the wiring support member:

Art Unit: 3679

is positioned in the reinforcement section,  
extends at least partially around a central axis of the tubular  
section, and

supports at least the first reinforcement wiring along its length.

In regards to claim 2, Hammond discloses the wiring support member comprising a first wiring support member, the first wiring-support member comprising a base (tangent) and retention walls, the retention walls defining a retention region therebetween, and the first reinforcement wiring being positioned in the retention region.

In regards to claim 3, Hammond discloses the base of the first wiring support member being positioned parallel to the first and second substrates, with the retention region facing the second substrate.

In regards to claim 4, Hammond discloses the wiring support member supporting (capable) a plurality of overlapping layers of the first reinforcement wiring.

In regards to claim 15, Hammond discloses the end portions respectively end in retaining rings.

In regards to claim 16, Hammond discloses first and the second substrates being made of a polymeric material.

In regards to claim 25, Hammond discloses a wiring support member (36) comprising:

a substantially annular body having retention walls for at least partially facilitating lengthwise winding of the reinforcement wiring around the wiring support member.



Art Unit: 3679

In regards to claim 26, Hammond discloses the annular body further comprising a base from which the retention walls extend radially outward, wherein a retention region is at least partially defined between the retention walls, and the retention region is for receiving the reinforcement wiring.

In regards to claim 27, Hammond discloses a cross-section of the wiring support member being substantially U-shaped, with the cross-section being taken along a plane which is parallel to and intersects an axis which the wiring support member extends around.

Claims 1-7, 15, 16 and 25-27 are rejected under 35 U.S.C. 102(b) as being anticipated by US patent 3429592, Merkwacz.

In regards to claim 1, Merkwacz discloses an elastomeric expansion joint comprising:

- at least one first substrate (30);

- at least one second substrate (36);

- fabric layers (22a,b) arranged between the first and the second substrates, defining a tubular section, wherein:

  - the tubular section comprises:

    - first and second end portions, a moveable central region (20), and

    - first and second intersection portions which are respectively defined between each of the end portions and the central region, and the intersection portions and the end portions define a reinforcement section;

Art Unit: 3679

a first reinforcement wiring (24, 26) positioned in the reinforcement section;  
a second reinforcement wiring (28) positioned between the first and second substrates in the intersection portions; and  
at least one wiring support member (34) positioned between the first and the second substrates, wherein the wiring support member:  
is positioned in the reinforcement section,  
extends at least partially around a central axis of the tubular section, and  
supports at least the first reinforcement wiring along its length.

In regards to claim 2, Merkwacz discloses the wiring support member comprising a first wiring support member, the first wiring support member comprising a base and retention walls, the retention walls defining a retention region therebetween, and the first reinforcement wiring being positioned in the retention region.

In regards to claim 3, Merkwacz discloses the base of the first wiring support member being positioned parallel to the first and second substrates, with the retention region facing the second substrate.

In regards to claim 4, Merkwacz discloses the wiring support member supporting a plurality of overlapping layers of the first reinforcement wiring.

In regards to claim 5, Merkwacz discloses the plurality of layers of the first reinforcement wiring being arranged in the retention region up to terminuses of the retention walls (but not contacting).

Art Unit: 3679

In regards to claim 6, Merkwacz discloses second wiring support members being respectively positioned in the first and second intersection portions.

In regards to claim 7, Merkwacz discloses each of the second wiring support members comprising retention walls defining a retention region therebetween, with the second reinforcement wiring positioned in the retention regions of the second wiring support members.

In regards to claim 15, Merkwacz discloses the end portions respectively end in retaining rings.

In regards to claim 16, Merkwacz discloses first and the second substrates being made of a polymeric material.

In regards to claim 25, Merkwacz discloses a wiring support member (34) comprising:

a substantially annular body having retention walls for at least partially facilitating lengthwise winding of the reinforcement wiring around the wiring support member.

In regards to claim 26, Merkwacz discloses the annular body further comprising a base from which the retention walls extend radially outward, wherein a retention region is at least partially defined between the retention walls, and the retention region is for receiving the reinforcement wiring.

In regards to claim 27, Merkwacz discloses a cross-section of the wiring support member being substantially U-shaped, with the cross-section being taken along a plane which is parallel to and intersects an axis which the wiring support member extends around.

Art Unit: 3679

Claims 25-27 are rejected under 35 U.S.C. 102(b) as being anticipated by US patent 2879804, Hammond.

In regards to claim 25, Star discloses a wiring support member (17) comprising:  
a substantially annular body having retention walls for at least partially facilitating lengthwise winding of the reinforcement wiring around the wiring support member.

In regards to claim 26, Star discloses the annular body further comprising a base from which the retention walls extend radially outward, wherein a retention region is at least partially defined between the retention walls, and the retention region is for receiving the reinforcement wiring.

In regards to claim 27, Star discloses a cross-section of the wiring support member being substantially U-shaped, with the cross-section being taken along a plane which is parallel to and intersects an axis which the wiring support member extends around.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hammond in view of US patent 3976312, Murphree.

Art Unit: 3679

In regards to claim 17, Hammond discloses the claimed invention except for a polytetrafluorethylene layer. Murphree teaches a polytetrafluorethylene layer (col. 1, lines 65-68). As Murphree relates to an expansion joint, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a polytetrafluorethylene layer, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

### ***Allowable Subject Matter***

Claims 7-14 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron M Dunwoody whose telephone number is 571-272-7080. The examiner can normally be reached on 7:30 am - 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P Stodola can be reached on 571-272-7087. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3679

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Aaron M Dunwoody  
Primary Examiner  
Art Unit 3679

.amd